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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,341	10/14/2003	G. Eric Engstrom	109909-135058	7187

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EXAMINER

STEIN, JULIE E

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/686,341	Applicant(s) ENGSTROM, G. ERIC	
	Examiner Julie E. Stein, Esq.	Art Unit 2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 3-4, 6, 9, 11-12, 14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0158812 to Pallakoff.

Pallakoff discloses all the elements of independent claim 1, including a mobile communication device (Figures 1A to 3C) comprising: a transceiver to facilitate transmission and receipt of audio communication (inherent in that this is a mobile phone); a display to display information (Figures 1A to 3C); a scroll button (Figure 1B, element 102); and scrolling logic coupled to the scroll button and the display to scroll the information displayed on the display at a variable scroll rate responsive to at least a

selected one of an amount of time the scroll button has been pressed, and an amount of pressure applied to the scroll button (paragraph 62).

The rejection of claim 1 is hereby incorporated. Pallakoff discloses all the steps of independent claim 9, including in a mobile communication device (Figures 1A to 3C), a method of operation comprising: receiving indication of a scroll button (Figure 1B, element 102) of the mobile communication device being pressed (paragraph 62); and scrolling information displayed on a display of the mobile communication device at a variable scroll rate, responsive to a selected one of an amount of time the scroll button has been pressed and an amount of pressure applied to the scroll button (Id.).

Pallakoff discloses all the elements/steps of claims 3-4 and 11-12, including wherein the scrolling logic is designed to scroll the information displayed on the display at increasing scroll rate responsive to the amount of pressure applied to the scroll button and wherein the mobile communication device further comprises a pressure sensor to sense the amount of pressure applied to the scroll button. See, paragraph 62.

Pallakoff discloses all the elements/steps of claims 6 and 14, including the mobile communication device comprises a wireless mobile phone. See, Figures 1A to 3C.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2685

4. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pallakoff in view of U.S. Patent No. 6,539,243 to Kimura et al.

Pallakoff teaches all the elements/steps of claims 2 and 10, except wherein the scrolling comprises scrolling the information displayed on the display at increasing scroll rate responsive to the amount of time the scroll button has been pressed. However, Kimura teaches a method of using scroll buttons in which the scroll buttons are held down for various lengths of times in order to execute various functions. See column 3, line 64 to column 4, line 26. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to add this functionality to the method of Pallakoff because it is another way in which to scroll through various displayed information, such as different types of searches. See, Kimura, column 4, lines 17 to 27.

5. Claims 5, 7-8, 13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pallakoff in view of U.S. Patent No. 6,198,473 to Armstrong.

The rejection of claims 1 and 9 are hereby incorporated. Pallakoff teaches all the elements of independent claim 7, including a mobile communication device comprising: a transceiver to facilitate transmission and receipt of audio communication (inherent in that this is a mobile phone); a display to display information (Figures 1A to 3C); a scroll button (Figure 1B, element 102); and scrolling logic coupled to the scroll button and the display to scroll the information displayed on the display in response to a selection of the scroll button (paragraph 62). However, Pallakoff does not teach stopping said scrolling gradually in response to a de-selection of the scroll button.

But, Armstrong teaches the use of a scroll button and that when the pressure applied to the scroll button is reduced, the rate of scrolling is slowly stopped so that targeted information may be accurately selected. See column 6, lines 40 to 46. Therefore, one of ordinary skill in the art at the time the invention was made would have added the functionality taught by Armstrong to the method of Pallakoff because it would allow a user to more accurately select desired information. See *Id.*

The rejection of claim 7 is hereby incorporated. Pallakoff discloses all the steps of independent claim 15, including in a mobile communication device (Figures 1A to 3C), a method of operation comprising: receiving indication of a scroll button (Figure 1B, element 102) of the mobile communication device being pressed (paragraph 62). However, Pallakoff does not teach in response, gradually stopping scrolling of information displayed on a display of the mobile communication device.

But, Armstrong teaches the use of a scroll button and that when the pressure applied to the scroll button is reduced, the rate of scrolling is slowly stopped so that targeted information may be accurately selected. See column 6, lines 40 to 46. Therefore, one of ordinary skill in the art at the time the invention was made would have added the functionality taught by Armstrong to the method of Pallakoff because it would allow a user to more accurately select desired information. See *Id.*

The rejections of claims 7 and 15 are hereby incorporated. Pallakoff in view of Armstrong teach all the elements/steps of claims 5 and 13, including stopping said scrolling gradually in response to cessation of said pressing of said scroll button. See above.

Pallakoff in view of Armstrong discloses all the elements/steps of claims 8 and 15, including the mobile communication device comprises a wireless mobile phone. See, Pallakoff, Figures 1A to 3C.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Stein, Esq. whose telephone number is (571) 272-7897. The examiner can normally be reached on M-F (8:30 am-5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JES

Nguyen Vo
7/25/2005

**NGUYENT.VO
PRIMARY EXAMINER**